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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,545	01/29/2004	Steven M. Goetz	1023-261USD1	5360
28863 7590 09/09/2008 SHUMAKER & SIEFFERT, P. A. 1625 RADIO DRIVE SUITE 300 WOODBURY, MN 55125				
EXAMINER				
BOCKELMAN, MARK				
ART UNIT		PAPER NUMBER		
3766				
NOTIFICATION DATE		DELIVERY MODE		
09/09/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pairedocketing@ssiplay.com

### Office Action Summary

**Application No.**

10/767,545

**Applicant(s)**

GOETZ, STEVEN M.

**Examiner**

Mark W. Bockelman

**Art Unit**

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-23, 32-41, 50-54 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Snell USPN 5,716,382.

As an example, referring to figure 4, the algorithm selects at (2) a first parameter configuration in the form of a pacemaker stimulation. The user is prompted for an input regarding the efficacy of the pacing in terms of it's frequency of usefulness (2) and upon whether the pacing indicates neuroregulatory abnormality or not. The result of its efficacy and the location of the first parmeter configuration (at the top of the tree) selects a second parameter configuration, either VVI or DDI (1) pacing. Similarly at blocks 5 and 6, the efficacy of the pacing, which can be observed along with the responsiveness

of the ventricular rate to physiological stimuli. The examiner does not give weight to whether the efficacy is "observed" during pacing or not since applicant's device merely receives an input. However, to have employed the method during pacing in various configurations would have been obvious. In addition, the examiner considers the algorithm to be a computer readable medium. The pacing suggestions would entail polarity outputs to the electrode leads. VVI and DD1 involve different target regions of the heart. The examiner considers subsequent use of the programmer to update the decision tree that was followed during it's first use.

Claims 19-54 rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll et al USPN 7,123,961 in view of Snell USPN 5,716,382.

Kroll et al teach the optimization of nerve stimulation by a device that determines (23: 15-17) an observed efficiency (optimal efficiency) (23:17-30) as well as several decision trees including one that selects leads and electrodes (23:1-15) through a decision process (tree) as well as a decision tree determining the type of stimulation (figure 8). Applicant's limitations of intended use such as lead placement and suggesting a configuration to the user are given no patentable weight since the leads and communication devices are not specified as part of the recited invention. The suggesting can be merely what is stored in the device. The iteration may be stopped once an optimal configuration has been found including an iteration through all configurations (iteration limit). The selection prior to stimulation (claim 32) maybe based upon performance and the selection of the configurations is a "suggestion" to try the next configuration to the user. Applicant differs in reciting a hierarchy branch of

electrode configurations to form a decision tree to determine the optimal settings. To have used such a well known method for selecting configurations in a known manner would have been obvious in view of Snell 5,716,382.

With respect to claims 30-31, 48-49, applicant differs in providing electrode nodes which could merely be yes/no decision blocks indicating iteration termination based upon the configuration efficiency. Such an inclusion would be an obvious operation for carrying out the Kroll et al method with to achieve the same desired result.

### ***Response to Arguments***

Applicant's arguments filed 5-28-2008 have been fully considered but they are not persuasive. Applicant argues more narrowly that that which is claim. Removing the intended use from, for example claim 1. Applicant recites an algorithm that selects a first element and receives a signal then outputs a second signal capable of selecting a second element as a result of the received signal which is capable of directing the device to another element. The intended use in which this basic algorithm is immersed is directed to its operation on a decision tree based upon the received signal being an efficiency. If applicant were to recite a means for determining an efficiency the device and to actually claim a claim tree on which the parameters are found, the examiner might find appellant's arguments to be more compelling. However, since only an algorithm that operates some type of input/output, it is not seen to overcome the art at this time. The scope of the claim is merely includes the instructions of how the device operates on the inputs and outputs to select elements and not the actual inputs and outputs at this time.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on (571) 272 -4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark W Bockelman/  
Primary Examiner, Art Unit 3766  
September 2, 2008